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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/560,341 04/28/00 TOUSI

S 8409-000030

EXAMINER

PM82/0315

INTELLECTUAL PROPERTY DEPARTMENT
FREUDENBERG-NOK GENERAL PARTNERSHIP
47690 EAST ANCHOR COURT
PLYMOUTH MI 48170-2455

CARPENTER, S
ART UNIT

PAPER NUMBER

3612
DATE MAILED:

03/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Applicati n No.

09/560,341

Applicant(s)

TOUSI ET AL.

Examiner

Scott A. Carpenter

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 1-20 is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 3
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: ____

DETAILED ACTION

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 50. Correction is required.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: L', V, 36, 44, 62, 65, Correction is required.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "14" has been used to designate both the foamed elastomeric annular portion and the top portion of the foamed elastomeric annular portion. Correction is required.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the body having an aperture (more specifically, the aperture) and the arcuate inner axial surface having parabolic and oval cross sectional areas must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
5. The drawings are also objected to for the following reasons:

On page 5, line 18, the specification refers to the inner diameter of axially extending portion (20) using reference character "24". This is obviously incorrect, as in Fig. 3, "24" points out the axially extending tube, and in Fig. 2, "24" points to the outer diameter of the axially extending portion (20).

In Fig. 3, reference character "H" points to the hole in the subframe, yet in Fig. 4, "H" points to the elastomeric lower mount.

Figs. 3 and 4 show tubular portion '28' as having an inner diameter which roughly matches the outer diameter of the bolt. Fig. 5 shows tubular member '28' as being much larger than the bolt and having a material '50' (not discussed in the specification) interposed between the bolt and the tubular member. Additionally, the bolt '70' appears to have a tubular member around it which was not discussed in the specification.

Fig. 6 does not show the same structure as Fig. 4, wherein the upper portion has a step to accommodate extending portion 20. This makes it wholly unclear as to whether Applicant is intending to illustrate different embodiments (not mentioned in the specification) or if it is an error in the drawings.

Fig. 4 shows reference character '32' pointing to a flange portion on insert '30', and not to an outer diameter (as described in the specification on page 6, line 2).

In Fig. 4, reference character '40' points to the flange portion of the insert '30' (as described in the specification), yet in Fig. 6, '40' points to the upper annular portion '14'.

On line 7 of page 6, the specification makes reference to the "peripheral shape 34" of the insert portion, when in the drawings, reference character '34' points to an inner axially extending portion of the upper annular portion.

In Fig. 6, reference character '48' points to an annular axially extending elastomeric layer (as described in the specification), yet in Fig. 4, reference character '48' points to the tube portion (42) of the insert (30).

In Figs. 3 and 4, reference character '15' points to both the axial length of the upper annular portion and the annular portion itself.

Correction is required.

6. The disclosure is objected to because of the following informalities: on page 5, line 20, it appears that reference character "35" should be changed to --25--. On line 16 of page 6, "12" should be changed to --10--. On line 7 of page 8, it appears that "24" should be changed to --22--. On lines 18 and 19 of page 8, reference character "20" should be changed to --10--. The disclosure is objected to because of the following informalities: the paragraph beginning on line 11 of page 9 appears to be a substantial duplicate of the last part of the previous paragraph, and should be removed. Appropriate correction is required.

7. Applicant is advised that should claims 16 and 20 be found allowable, claim 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

8. Claims 2, 8-11, and 18 are objected to for the following grammatical informalities:

On line 2 of claim 2, "further having" should be changed to --further comprises-- or --further has-- or the like.

On line 2 of claim 8, "being engaged" should be changed to --is engaged-- or the like.

On line 2 of claims 9 and 10, "affecting" should be changed to --affects-- or the like.

On lines 15 and 16 of claim 11, "attenuating" should be changed to --attenuates-- or the like.

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On line 2 of claim 18, "forming" should be changed to --forms-- or the like.

Appropriate correction is required.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because in view of the numerous objections to the drawings and specification, the details of the structure which Applicant is attempting to disclose are wholly unclear and would not enable one of ordinary skill in the art to make or use the invention.

10. Claims 1-20 are rejected under 35 U.S.C. 112, First Paragraph, as claiming subject matter that was not fully and clearly disclosed enough in the specification so as to allow one of ordinary skill in the art to make or practice the invention. Additionally, because of the rejections under 35 U.S.C., First Paragraph, a full examination of the claims on the merits in view of prior art cannot

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be made. Applicant is advised, however that the prior art cited by the Examiner in this action may be applicable to the instant application.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-10, claim 1 recites two separate passageways (lines 8 and 12), and line 15 recites that the elliptical retainer member is disposed "in said passageway". It is unclear as to which passageway Applicant intends to refer, and therefore renders the claim indefinite as best understood. Additionally, the specification does not disclose an elliptical retainer member as recited in line 15 of claim 1, and therefore it is unclear as to what specific part of the structure Applicant is intending to recite, thereby rendering the claim indefinite as best understood. Consequently claims 2-10 are rejected as being dependent on a rejected base claim.

Regarding claims 11-20, claim 11 recites that the arcuate annular portion has an inner arcuate axial passage, said passage having an arcuate passageway. This is redundant, and therefore renders the claim indefinite as best understood. Additionally, the specification does not disclose a retainer member as recited in line 10 of claim 11, and therefore it is unclear as to what specific part of the structure Applicant is intending to recite, thereby rendering the claim indefinite as best understood. Consequently claims 11-20 are rejected as being dependent on a rejected base claim.

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Claims 4, 16, and 20 contain the trademark/trade name Neoprene. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe an elastomer and, accordingly, the identification/description is indefinite.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adams (U.S. Patent 3,266,139), Komabashiri (U.S. Patent 5,152,510), Killworth et al. (U.S. Patent 5,170,985), Moore et al. (U.S. Patent 5,219,439), Schindler et al. (U.S. Patent 5,597,173), Gautheron (U.S. Patent 5,865,429), Carlson (U.S. Patent 6,189,874), Kanda (U.S. Patents 5,299,788 and 5,813,665), Willett (U.S. Patent 5,799,930), Baratoff (U.S. Patent 3,245,646), Jaskowiak (U.S. Patent 3,250,565), Nakagaki et al. (U.S. Patent 5,295,671), Tandy, Jr. et al. (U.S. Patent 5,636,857), Kojima (U.S. Patent 5,704,598), and Lee (U.S. Patent 5,718,407) all disclose vibrational isolation mounts.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Carpenter whose telephone number is 703-308-6290. The examiner can normally be reached on Mon. - Thurs. 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Glenn Dayoan can be reached on 703-308-3102. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-308-3297 for regular communications and 703-308-3297 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

sac
March 8, 2001



3/8/01

SCOTT CARPENTER
PATENT EXAMINER



3/12/01

D. GLENN DAYOAN
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